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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,025	08/27/2001	Steven B. Volk	M-12039 US	4900
32605	7590	07/05/2005	EXAMINER	
MACPHERSON KWOK CHEN & HEID LLP 1762 TECHNOLOGY DRIVE, SUITE 226 SAN JOSE, CA 95110			BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER

3621

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,025

Applicant(s)

VOLK ET AL.

Examiner

Bradley B. Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

In the response filed on April 4, 2005 with respect to the rejection of claims 1-16, applicant has canceled claims 8-15. Examiner's rejection with respect to claims 8-15 is otherwise moot. Thus, claims 1-7 and 16 remain pending.

Response to Arguments

Applicant's arguments filed April 4, 2005 have been fully considered but they are not persuasive.

As per claim 1, applicant asserts that the cited reference (Christiano, 5,671,412) does not disclose the use of media disk identifiers, including a code associated with a vendor (response page 4). Applicant further contends that Christiano is "plainly a host based" digital rights management system (response p. 4).

As to the breadth, scope and application of Christiano's DRM system, the applicant is directed to column 26, lines 45-65. Christiano indicates that a license database is initialized wherein package descriptions and license items are read from an external file, external database or other storage medium (media disk, i.e., CD), which stores license data and package license descriptions for the license (column 10, lines 7-24). Christiano further describes identifiers and keys to store, verify and authenticate various data such as parameters of use, user name, host name, terminal name/location, vendor name, serial number, node/location address etc. (column 6, lines 60-67; column 8, lines 57-67; column 9, lines 35-39; column 23, line 40-column 24, line 29). In addition, Christiano discloses a "finder" process wherein the location of the license server can be determined as described and illustrated in columns 23-24 and figures 10-12.

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Applicant further contends that claims 4-7 are not anticipated by the cited reference since they include a further limitation, namely, a “software installation component operable to install an identifier on a media disk (response page 4).”

Christiano discloses that key/identifiers as previously described can be synthesized at the time of the license record creation and stored in an external file (column 15-16).

As per applicant’s argument regarding claim 16, applicant is directed to claims 31-41 of Christiano and applicant’s disclosure with reference to signal bearing media.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Christiano, U.S. Patent 5,671,412.

As per the following claims, Christiano discloses:

1. A method of identifying a location associated with a vendor of a media disk holding content, the method comprising:

- providing instructions for the media disk (column 4, lines 35-57; column 10, lines 7-24);
- during an install of the media disk into a host according to the instructions, installing an identifier on the media disk, the identifier including a code associated with the vendor (figure 2a and associated text, column 8, lines 5-56; column 6, lines 60-67; column 8,

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lines 57-67; column 9, lines 35-39; column 23, line 40-column 24, line 29; figures 10-13 and associated text); and

- after transmitting data to a server, reading the identifier to find a location associated with the vendor, the location being associated with the vendor of the media disk and independent of any vendors that are not associated with the media disk (columns 23-24; figure 10-12 and associated text).

2. The method of claim 1 wherein the instructions for the media disk include identifying a vendor from whom the media disk was purchased (figure 7 and associated text; column 15, line 45-column 16, line 39).

3. The method of claim 1 wherein the identifying the vendor from whom the media disk was purchased includes providing in the instructions one of a code, a universal resource locator (URL), a cryptographic key associated with the vendor, and a part of a cryptographic key associated with the vendor (figures 13-15 and associated text).

4. A system for identifying a location associated with a vendor of a media disk holding content, the system comprising: instructions for the media disk; and a software installation component associated with the media disk, the software installation component installation during an install of the media disk into a host according to the instructions, the software installation component operable to install an identifier on the media disk, the identifier including a code associated with the vendor, the identifier associated with a location of the vendor to such that a connection

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between the host and a server is operable to open the location (column 23, line 24 – column 26, line 60).

5. The system of claim 4 wherein the instructions for the media disk include identifying a vendor from whom the media disk was purchased (figure 7 and associated text; column 15, line 45- column 16, line 39).

6. The system of claim 4 wherein the identifying the vendor from whom the media disk was purchased includes providing in the instructions one of a code, a universal resource locator (URL), a cryptographic key associated with the vendor, and a part of a cryptographic key associated with the vendor (figures 13-15 and associated text)

7. The system of claim 4 wherein the location is an Internet location including web pages for unlocking content stored on the media disk, the Internet location further providing optional offers for purchase over the Internet by the vendor (column 23, line 25 – column 26, line 10).

16. A computer program product, the computer program product comprising: signal bearing media having programming adapted to: instantiate during an install of the signal bearing media into a host according to instructions; and install an identifier on the signal bearing media, the identifier including a code associated with a vendor of hidden content on the signal bearing media, the identifier associated with a location of the vendor to such that a connection between

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the host and a server is operable to open the location (rejected as above; see claims 31-41 in Christiano).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

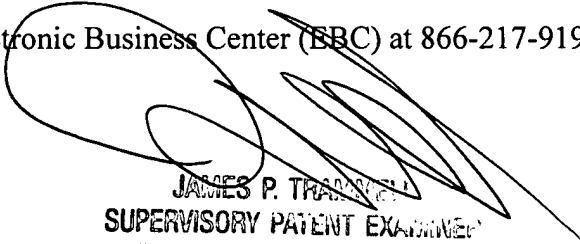
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday-Friday 8am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb



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